

REMARKS

Claims 1-16 and 20-32 are pending in this application. Claims 20-32 are withdrawn from consideration. By this Amendment, claims 1-5, 7, 8, 10-13, 20, 24-26, 29 and 32 are amended and claims 17-19 are canceled. No new matter is added.

In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

I. Restriction Requirement

In reply to the Restriction Requirement, Applicant confirms the election of Group I, claims 1-16, with traverse.

In response to the Restriction Requirement, Applicant respectfully submits that there exists *a priori* unity of invention with respect to claims 1-32, by virtue of the fact that claims 2-32 variously depend from claim 1 and thus share common subject matter.

The Office Action, at page 3, asserts that EP 0985694 to Okuhira et al. ("Okuhira") discloses the aldiminoalkylsilane of claim 1 (Okuhira, Formula 2, Formula 4 and Formula 13). However, for at least the reasons described below, Applicant respectfully submits that Okuhira fails to disclose each special technical feature that is common to claims 1-32, and thus does not establish a lack of unity of invention.

In particular, Okuhira does not disclose a formula where Y^3 comprises either: (1) an alkyl group having at least one hetero atom; (2) an alkyl or alkylene group having at least 10 carbon atoms; (3) an aryl or arylalkyl group; or (4) an OR^4 , $OCOR^4$ or CO_2R^4 group, as recited in claim 1 (Okuhira, paragraph [0060]). Okuhira merely discloses aldehydes with $R^1 = C_1-C_6$ alkyl, $R^2 =$ methyl or ethyl, and $R^3 =$ H, methyl or ethyl. Thus, the present invention is distinguishable from the composition disclosed in Okuhira and as a result Okuhira fails to disclose all of the special technical features recited in claims 1-32. Therefore, Applicants

respectfully submit that lack of unity of invention has not been established, and thus the restriction requirement is improper.

Accordingly, withdrawal of the Restriction Requirement is respectfully requested.

II. Rejection Under 35 U.S.C. §112

The Office Action rejects claims 1-4, 7, 8, 10, 11 and 13 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Without conceding to the propriety of the rejection, by this Amendment, claims 1-4, 7, 8, 10, 11 and 13 are amended in light of the Examiner's comments, and claim 5 is amended for clarity. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection.

III. Rejection Under 35 U.S.C. §102

The Office Action rejects claims 1-5, 9 and 13 under 35 U.S.C. §102(b) over Okuhira. The above discussion with respect to the Restriction Requirement is incorporated herein by reference.

As described above, Okuhira fails to disclose, either expressly or inherently, each and every feature of independent claim 1 and, thus, does not anticipate claim 1. More specifically, Okuhira does not disclose a formula with a component having (1) an alkyl group having at least one hetero atom; (2) an alkyl or alkylene group having at least 10 carbon atoms; (3) an aryl or arylalkyl group; or (4) an OR⁴, OCOR⁴ or CO₂R⁴ group, such as Y³ recited in claim 1. Claims 2-5, 9 and 13 variously depend from claim 1 and, thus, are also not anticipated by Okuhira.

Accordingly, for at least the reasons set forth above, reconsideration and withdrawal of the rejection are respectfully requested.

IV. Rejection Under 35 U.S.C. §103

The Office Action rejects claims 14 and 15 under 35 U.S.C. §103(a) over Okuhira; rejects claims 6 and 16 under 35 U.S.C. §103(a) over Okuhira in view of U.S. Patent No.

4,853,454 to Merger et al. ("Merger"); and rejects claims 7, 8 and 10-12 under 35 U.S.C. §103(a) over Okuhira in view of U.S. Patent No. 5,010,161 to Aoki et al. ("Aoki"). Applicant respectfully traverses the rejections.

A. Okuhira

Claims 14 and 15 variously depend from claim 1 and, therefore, contain all of the features of claim 1. Thus, the deficiencies of Okuhira with respect to claim 1, as discussed above, are applicable to claims 14 and 15. The Office Action provides no reason or rationale for one of ordinary skill in the art to have modified Okuhira to have included an element such as Y³ recited in claim 1.

Furthermore, the Office Action concedes that Okuhira fails to disclose an embodiment where water is completely removed from the reaction mixture of an aminoalkylsilane of formula I and an aldehyde of formula II (*see* Office Action, pages 5-6). The Office Action further asserts it would have allegedly been obvious for one of ordinary skill in the art to modify Okuhira's process based on Le Chatelier's principle (*see* Office Action, page 6). However, for at least the reasons below, the alleged disclosure of Okuhira would not have rendered obvious all of the features of claims 14 and 15.

First, the Office Action fails to provide a technical reasoning why one of ordinary skill would have modified Okuhira to be completely depleted of water based on Le Chatelier's principle. Additionally, Okuhira discloses a polycondensate of the silicon-containing ketimine formed by the water separated in a dehydration reaction between the aminoalkylsilane and an aldehyde or ketone (Okuhira, paragraph [0080]). However, Okuhira fails to disclose that such a formation reaction produces unfavorable results as described in the specification (*see* paragraphs [0011], [0012] and [0031]) and, thus, Okuhira nor the Office Action provides any reason or rationale for one of ordinary skill in the art to have modified

the reference. Thus, Applicant respectfully asserts that the applied reference would not have rendered claims 14 and 15 obvious.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

B. Okuhira in view of Merger

Claims 6 and 16 variously depend from claim 1 and, therefore, contain all of the features of claim 1. Thus, the deficiencies of Okuhira with respect to claim 1, as discussed above, are applicable to claims 6 and 16. As discussed above, Okuhira fails to disclose, and likewise fails to teach, suggest, or establish any reason or rationale to provide the combination of features recited in claim 1. Merger is applied by the Office Action only for the additional features recited in claims 6 and 16 and does not cure the deficiencies of Okuhira with respect to claim 1.

The Office Action asserts that it would have allegedly been obvious to modify Okuhira by substituting the aldehydes of Merger into the reaction of Okuhira to obtain a mixture of aldiminoalkylsilane and polyaldimines. However, both references fail to disclose the odor with respect to the aldehydes and aldimines of Okuhira, the odor advantages of certain aldehydes and aldimines of Merger, or the difficulties with respect to siloxane formation if water is not removed during preparation of the silane terminated aldimine. In fact, the Office Action fails to provide any benefit or desirability for one of ordinary skill in the art to have chosen the aldehydes of Merger other than the assertion that it is possible.

Based on the above, the mere fact that references can be combined or modified does not render the resultant combination obvious in the absence of some reason or rationale for the combination. However, the references and the Office Action fail to provide a viable reason to modify the references, without the benefit of Applicant's specification (*see* paragraphs [0012] and [0031]), and thus would not render claims 6 and 16 obvious.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

C. Okuhira in view of Aoki

Claims 7, 8 and 10-12 variously depend from claim 1 and, therefore, contain all of the features of claim 1. Thus, the deficiencies of Okuhira with respect to claim 1, as discussed above, are applicable to claims 7, 8 and 10-12. As discussed above, Okuhira fails to disclose, and likewise fails to teach, suggest, or establish any reason or rationale to provide the combination of features recited in claim 1. Aoki is applied by the Office Action only for the additional features recited in claims 7, 8 and 10-12 and does not cure the deficiencies of Okuhira with respect to claim 1.

The Office Action asserts that it would have allegedly been obvious to modify Okuhira by substituting the aldehydes of Aoki into the reaction of Okuhira to obtain the aldiminoalkylsilanes recited in claims 7, 8 and 10-12. However, these applied references also fail to disclose the odor issue with respect to the aldehydes and aldimines of Okuhira and the difficulty with respect to siloxane formation if water is not removed from during preparation of the silane terminated aldimine. In fact, the Office Action fails to provide any benefit or desirability for one of ordinary skill in the art to have chosen the aldehydes of Aoki other than the assertion that it is possible.

Accordingly, the mere fact that references can be combined or modified does not render the resultant combination obvious in the absence of a reason or rationale for the combination. However, the references and the Office Action fail to provide a viable reason to have modified the references, without the benefit of Applicant's specification (*see* paragraphs [0012] and [0031]), and thus would not render claims 7, 8 and 10-12 obvious.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Nicolas A. Brentlinger
Registration No. 62,211

JAO:SQL/scg

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OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

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